

TRANSMITTAL

PETITION UNDER 37 CFR 1.181  
AND  
MPEP 1002.02(c)(3)

Title: KNIFE INDEXING APPARATUS  
Inventor: Mark Rasper  
Filed: 12/28/99  
Serial No.: 09/222,282  
Art Unit: 3724  
Examiner: K. Tran

RECEIVED

MAY 26 2000

OFFICE OF PETITIONS  
DEPUTY A/C PATENTS

To the Commissioner of Patents and Trademarks  
Washington D.C. 20231

ATTN: GROUP DIRECTORS

Transmitted herewith is a Petition under 37 CFR 1.181 seeking reversal of a final rejection is the above cited patent application.

Included are;

- 3 Pages of petition
- 1 Copy of the office action of 05/09/00.
- 1 Money order in the amount of \$130.00 as the fees for the filing of the petition.
- 1 Self addressed Post Card

TC 3700 MAIL ROOM

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Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

The Commissioner of Patents and Trademarks  
Washington D.C. 20231

on MAY 22, 2000

(Date)

Russell L. Johnson

(Name of person making deposit)

*Russell L. Johnson*

(Signature)

*May 22, 2000*

(Date)

05/26/2000 VAN11 00000002 09222282 01 FC:122 130.00 0P

benefits of Provisional Patent Application 60/070,405 filed 01/05/98. It contained two claims.

On 12/22/99 examiner Tran issued an office action requiring election/restriction.

On 01/4/00 the applicant responded to the requirement of 12/22/99 and elected to prosecute claim 1.

On 02/10/00 examiner Tran with the apparent approval of Supervisory Examiner Rada rejected claim 1 under 35 USC 103(a) as being unpatentable over Bailey in view of Cavelli. The issue date of Bailey is 06/09/98.

On 03/08/00 the applicant filed a response to examiner Tran's action of 02/10/00. He established that his Provisional Patent application was filed 01/05/98 and therefore Bailey was not available as a 35 USC 103 (a) reference on the date the invention was made.

On 05/09/00 examiner Tran with the apparent approval of Supervisory Examiner Rada issued an Office Action finally rejecting claim 1 ( a copy of the Office Action is attached) and presenting a theory that had Bailey been cited as a rejection under 35 USC 102 it would have qualified as a 35 USC 102 (e) rejection which is reliant on the filing date. The examiner does not make the hypothetical 35 USC 102(e) rejection and has cited no authority in support of his theory.

#### DISCUSSION OF THE APPLICABLE LAW

The examiners Tran and Rada's introduction of 35 USC 102(e) grounds for holding their 35 USC 103 rejection as proper based on hypothetical availability of Bailey as a 35 USC 102(e) anticipatory reference, is a new grounds for rejection and a new argument not previously presented and not necessitated by any amendment made by the applicant. By making the action final, the examiners deny the applicant a right to a full and fair

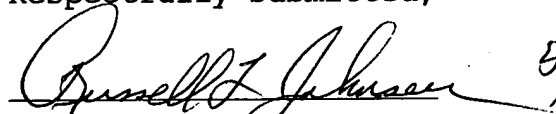
examination process.

Since it can be anticipated that a board of appeals would require the examiners to at the least cite an authority justifying the use of section 35 USC 102 practice as justification for an action taken in case where no 35 USC 102 rejection is present and to vacate a FINAL rejection which makes the applicant aware for the first time of a need to swear behind the filing date of the reference.

#### SUMMARY

For the forgoing reasons and to avoid unnecessary process and remand from a board of appeals, it is submitted that patent examiners erred in making the action of 05/09/00, FINAL and reversal is respectfully requested.

Respectfully Submitted,

 5/22/00

Russell L. Johnson

Patent Agent (26,918)

P.O. Box 161

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920/867-3482



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

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APPLICATION NO.	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/222,292

12/28/98

RASPER

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GM32/0509

EXAMINER
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TRAN, K

ART UNIT	PAPER NUMBER
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3724

DATE MAILED:

05/09/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/222,282

Applicant(s)

Rasper et al.

Examiner

Kim Ngoc Tran

Group Art Unit

3724

☒ Responsive to communication(s) filed on 3/8/00

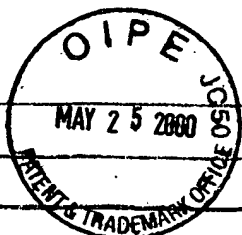
☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

- ☒ Claim(s) 1 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.



## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

1. This office action is response to applicant's communication received on March 8, 2000.

#### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey in view of Cavalli as set forth in the previous office action.

#### *Response to Arguments*

3. Applicant's arguments have been fully considered but they are not persuasive.

Applicant contends that Bailey was not available as a 35 USC 103(a) reference at the time of the invention because Bailey, U.S. Patent No. 5,761,976 was issued 6/9/98 while applicant's invention claims priority of the Provisional Patent Application 60/070,405 filed on 1/5/98. However, had Bailey been cited as a rejection under 35 U.S.C. 102, it would have qualified as a 35 U.S.C. 102(e) which is reliant on the filing date. Therefore, Bailey as a 35 U.S.C. 103 (a) reference is deemed proper.

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***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Ngoc Tran whose telephone number is (703) 305-2597.

6. Any general inquiry relating to this application can be directed to the Group receptionist at (703)-308-1148 or Supervisory Patent Examiner, Rinaldi Rada, at (703)-308-2187. Please submit facsimiles to the Group fax number at (703)-305-3579.

  
knt

May 5, 2000

  
Rinaldi I. Rada  
Supervisory Patent Examiner  
Group 3700